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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/826,212 | 04/05/2001 | Ying-Fei Wei | 1488.1280006 | 3523 |

28730 7590 07/03/2003

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

O HARA, EILEEN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1646

DATE MAILED: 07/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Applicati n No.

09/826,212

Applicant(s)

WEI ET AL.

Examin r

Eileen O'Hara

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 117 and 120-220.

Claim(s) objected to: _____.


Claim(s) rejected: 118 and 119.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____.
10. ☐ Other: _____

Continuation of 3. Applicant's reply has overcome the following rejection(s): all previous rejections under 35 USC 112, first and second paragraphs and the objections to claims 198, 200 and 202.

The Examiner's amendment mailed 6/17/2003 has been vacated at Applicants' request. Applicants' amendment after final filed May 12, 2003 was entered, and has overcome all previous rejections and objections. However, the amendments to claims 118 and 119 introduce new grounds of rejection under 35 USC §112, second paragraph. Specifically, the claims are indefinite because claim 117 encompasses an isolated polypeptide comprising amino acids 1 to 233 of SEQ ID NO: 2, and dependent claims 118 and 119 encompass the polypeptide of claim 117, further comprising amino acids -25 to 233 and amino acids -26 to 233, respectively, of SEQ ID NO: 2, so that it is not clear if the polypeptide comprises the original amino acids 1 to 233 of SEQ ID NO: 2, and additionally also comprises amino acids -25 to 233 of SEQ ID NO: 2 (or -26 to 233), which would contain a large duplication, or if it only comprises the additional amino acids of -25 to -1 (-26 to -1) of SEQ ID NO: 2. The rejection would be overcome by deleting the word "further" in claims 117 and 118.


YVONNE EYER, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600